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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/811,616

03/29/2004

Robert R. Parsons

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GO DADDY GROUP, INC.  
14455 NORTH HAYDEN ROAD  
SUITE 219  
SCOTTSDALE, AZ 85260

EXAMINER

STRODER, CARRIE A

ART UNIT

PAPER NUMBER

4154

MAIL DATE

DELIVERY MODE

09/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/811,616	<b>Applicant(s)</b> PARSONS, ROBERT R.	
	<b>Examiner</b> CARRIE A. STRODER	<b>Art Unit</b> 4154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities:

- a. Page 1: the cross references have only a blank for the patent application number;
- b. Page 2, 4<sup>th</sup> paragraph: "severely" is misspelled;
- c. Page 14, 3<sup>rd</sup> paragraph: "...a partnerships, a start-up businesses and an existing businesses looking..." should be corrected in order that the articles agree with the nouns they modify;
- d. Page 14, 4<sup>th</sup> paragraph: "...used only business activities..." should read "...used only for business activities..."
- e. Page 14, 5<sup>th</sup> paragraph: "...an associated Internet protocol addresses..." should be corrected in order that the article agree with the noun it modifies;
- f. Page 16, 1<sup>st</sup> full paragraph: makes reference to drawings 3a-c, 4 & 5; however there are no drawings numbered 3a-c or 5;
- g. Page 16, 2<sup>nd</sup> full paragraph: "accessible" is misspelled as "assessable";

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h. Page 16, 3<sup>rd</sup> full paragraph: "desire" should be "desired";

i. Page 17, 2<sup>nd</sup> full paragraph: "...will increase the Entrepreneur 101 chance..." should be "...will increase the Entrepreneur's 101 chance...";

j. Page 21, 1<sup>st</sup> paragraph: "...whether the work made for hire..." should be "...whether the work was made for hire..."; and

k. Page 24, 1<sup>st</sup> full paragraph: "...Entrepreneurs only have to be enter information and single time..." should be "...Entrepreneurs only have to enter information a single time..."

Appropriate correction is required.

2. The use of multiple trademarks has been noted in this application. They should be capitalized wherever they appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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***Claim Objections***

3. Claim 2 is objected to because of the following informalities: "...an available domain namess..." should be "...an available domain name..." Appropriate correction is required.

4. Claim 8 is objected to because of the following informalities: "...an available domain namess..." should be "...an available domain name..." Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981);

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*Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-18, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Go Daddy in view of Chauchard et al (US 20020042719 A1), hereinafter referred to as Chauchard.

8. Claim 1 describes a method for a Facilitator to assist an Entrepreneur in creating an Internet business,

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comprising the steps of: A) creating a Facilitator's web site on the Internet accessible to Entrepreneurs; B) registering a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site; and C) assisting the Entrepreneur on the Facilitator's web site in trademarking the domain name or the label with the United States Patent and Trademark Office. The Go Daddy Group, Inc. (hereinafter referred to as Go Daddy) has operated a website under the domain name of [www.godaddy.com](http://www.godaddy.com) where it has conducted step A since at least 27 November 1999. Go Daddy has also conducted step B since at least 02 March 2001. Go Daddy does not teach step C, assisting in trademarking a name, whether a domain name or otherwise as claimed. However, Chauchard does (paragraphs 75-80). Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

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9. Claim 2 is dependent on claim 1; therefore, the rejection of claim 1 is incorporated herein. Claim 2 further comprises the step of assisting the Entrepreneur on the Facilitator's web site in selecting an available domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business. Go Daddy has been registering domain names based on words chosen by the entrepreneur to describe his business since at least 02 March 2001. Further, Examiner takes Official Notice that this is the method by which most businesses choose their domain names. Considering [www.godaddy.com](http://www.godaddy.com) and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

10. Claim 3 is dependent on claim 1; therefore, the rejection of claim 1 is incorporated herein. Claim 3 further comprises the step of submitting an Entrepreneur's web site associated with the registered domain name to one

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or more search engines. Go Daddy has been submitting an Entrepreneur's web site associated with the registered domain name to one or more search engines since at least 28 March 2003. Considering [www.godaddy.com](http://www.godaddy.com) and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Go Daddy in view of Chauchard et al and further in view of USPTO (weblink).

Claim 4 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Go Daddy and Chauchard fail to teach further including the step of linking the Entrepreneur with the official web site for the United States Patent and Trademark Office. The United States Patent and Trademark Office has provided a link to trademark domain names since at least 17 January 1997. Considering [www.godaddy.com](http://www.godaddy.com), [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process

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implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

12. Claim 5 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 5 further includes the steps of receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office. Go Daddy and Chauchard do not teach this. However, the United States Patent and Trademark Office has conducted the above steps on its website, [www.uspto.gov](http://www.uspto.gov) since at least 29 February 2000. Considering [www.godaddy.com](http://www.godaddy.com), [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for

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trademarks before the USPTO as claimed with reasonable expectation of success.

13. Claim 6 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein. Claim 6 further includes the steps of receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to the United States Patent and Trademark Office. Go Daddy and Chauchard do not teach this. However, the United States Patent and Trademark Office has conducted the above steps on its website, [www.uspto.gov](http://www.uspto.gov) since at least 29 February 2000. Considering [www.godaddy.com](http://www.godaddy.com), [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

14. Claim 7 describes a method for a Facilitator to assist an Entrepreneur in creating an Internet business, comprising the steps of: A) creating a Facilitator's web

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site on the Internet accessible to Entrepreneurs; B) offering hosting services on the Entrepreneur's web site for the Entrepreneur's web site at an Internet protocol address associated with a registered domain name having a label and a top-level domain; and C) assisting the Entrepreneur on the Facilitator's web site in trademarking the domain name or the label with the United States Patent and Trademark Office. The Go Daddy Group, Inc.

(hereinafter referred to as Go Daddy) has operated a website under the domain name of [www.godaddy.com](http://www.godaddy.com) where it has conducted step A since at least 27 November 1999. Go Daddy has also conducted step B since at least 27 November 1999. Go Daddy does not teach step C, assisting in trademarking a name, whether a domain name or otherwise. However, step C is taught by Chauchard, paragraphs 75-80. Considering [www.godaddy.com](http://www.godaddy.com) and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

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Furthermore, creating a web site on the Internet is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and

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will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the act of creating a website can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

15. Claim 8 is dependent on claim 7; therefore the rejection of claim 7 is incorporated herein. Claim 8 further comprises the step of assisting the Entrepreneur on the Facilitator's web site in selecting and registering an available domain names based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business. Go Daddy has been registering domain names based on words

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chosen by the entrepreneur to describe his business since at least 02 March 2001. Further, Examiner takes Official Notice that this is the method by which most businesses choose their domain names. Considering [www.godaddy.com](http://www.godaddy.com) and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Furthermore, choosing a domain name that describes a business is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S.

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175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that choice of a domain name based on its description of a business adds little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning

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and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

16. Claim 9 is dependent on claim 7; therefore the rejection of claim 7 is incorporated herein. Claim 9 further comprises the step of submitting the Entrepreneur's web site located at the Internet protocol address to one or more search engines. Go Daddy has been submitting an Entrepreneur's web site associated with the registered domain name to one or more search engines since at least 28 March 2003. Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

17. Claim 10 is dependent on claim 7; therefore, the rejection of claim 7 is incorporated herein. Claim 10 further includes the step of linking the Entrepreneur with the official web site for the United States Patent and

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Trademark Office. Chauchard and Go Daddy do not teach this.

However, the United States Patent and Trademark Office has provided a link to trademark domain names since at least 17 January 1997. Considering Go Daddy, uspto.gov, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

18. Claim 11 is dependent on claim 7; therefore the rejection of claim 7 is incorporated herein. Claim 11 further includes the steps of receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office. Chauchard and Go Daddy do not teach this. However, the United States Patent and Trademark Office has conducted the above steps

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on its website, [www.uspto.gov](http://www.uspto.gov) since at least 29 February 2000. Considering Go Daddy, [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

19. Claim 12 is dependent on claim 7; therefore, the rejection of claim 7 is incorporated herein. Claim 12 further includes the steps of receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to the United States Patent and Trademark Office. Chauchard and Go Daddy do not teach this. However, the United States Patent and Trademark Office has conducted the above steps on its website, [www.uspto.gov](http://www.uspto.gov) since at least 29 February 2000. Considering Go Daddy, [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications

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as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

20. Claim 13 describes a method for a Facilitator to assist an Entrepreneur in creating an Internet business, comprising the steps of: A) creating a Facilitator's web site on the Internet accessible to Entrepreneurs; B) registering a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site; C) offering hosting services on the Facilitator's web site for the Entrepreneur's web site at an Internet protocol address associated with the registered domain name; and D) assisting the Entrepreneur on the Facilitator's web site in trademarking the domain name or the label with the United States Patent and Trademark Office. The Go Daddy Group, Inc. (hereinafter referred to as Go Daddy) has operated a website under the domain name of [www.godaddy.com](http://www.godaddy.com) where it has conducted step A since at least 27 November 1999. Go Daddy has also conducted step B since at least 27 November 1999. Go Daddy has also conducted step C since at least 27 November 1999. Go Daddy

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does not teach step D, assisting in trademarking a name, whether a domain name or otherwise. However, step D is taught by Chauchard, paragraphs 75-80. Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Furthermore, creating a web site on the Internet is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need

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not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the act of creating a website can add little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not

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explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

21. Claim 14 is dependent on claim 13; therefore the rejection of claim 13 is incorporated herein. Claim 14 further comprises the step of assisting the Entrepreneur in selecting the domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business. Go Daddy has been registering domain names based on words chosen by the entrepreneur to describe his business since at least 02 March 2001. Further, Examiner takes Official Notice that this is the method by which most businesses choose their domain names. Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Furthermore, choosing a domain name that describes a business is non-functional descriptive data.

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When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional

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relationship between the descriptive material and the substrate.

The Examiner asserts that choice of a domain name based on its description of a business adds little, if anything, to the claimed acts or steps and thus does not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

22. Claim 15 is dependent on claim 13; therefore, the rejection of claim 13 is incorporated herein. Claim 15 further comprises the step of submitting the hosted Entrepreneur's web site to one or more search engines. Go Daddy has been submitting an Entrepreneur's web site associated with the registered domain name to one or more search engines since at least 28 March 2003. Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the

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invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

23. Claim 16 is dependent on claim 13; therefore, the rejection of claim 13 is incorporated herein. Claim 16 further includes the step of linking the Entrepreneur with the official web site for the United States Patent and Trademark Office. Chauchard and Go Daddy do not teach this. However, the United States Patent and Trademark Office has provided a link to trademark domain names since at least 17 January 1997. Considering [www.godaddy.com](http://www.godaddy.com), [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

24. Claim 17 is dependent on claim 13; therefore, the rejection of claim 13 is incorporated herein. Claim 17 further includes the steps of receiving trademark

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information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office. Chauchard and Go Daddy do not teach this. However, the United States Patent and Trademark Office has conducted the above steps on its website, [www.uspto.gov](http://www.uspto.gov) since at least 29 February 2000. Considering Go Daddy, [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

25. Claim 18 is dependent on claim 13; therefore the rejection of claim 13 is incorporated herein. Claim 18 further includes the steps of receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to

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the United States Patent and Trademark Office. Chauchard and Go Daddy do not teach this. However, the United States Patent and Trademark Office has conducted the above steps on its website, [www.uspto.gov](http://www.uspto.gov) since at least 29 February 2000. Considering Go Daddy, [uspto.gov](http://uspto.gov), and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

26. Claim 19 describes a method for a Facilitator to assist an Entrepreneur in creating an Internet business, comprising the steps of: A) creating a Facilitator's web site on the Internet accessible to Entrepreneurs; B) receiving information regarding an Entrepreneur that has accessed the Facilitator's web site; C) storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site; D) registering a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site using at

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least some of the stored information regarding the Entrepreneur; and E) assisting the Entrepreneur on the Facilitator's web site in trademarking the domain name or the label with the United States Patent and Trademark Office using at least some of the stored information regarding the Entrepreneur. The Go Daddy Group, Inc. (hereinafter referred to as Go Daddy) has operated a website under the domain name of [www.godaddy.com](http://www.godaddy.com) where it has conducted steps A, B, C, and D since at least 27 November 1999. Go Daddy does not teach step E, assisting in trademarking a name, whether a domain name or otherwise. However this is taught by Chauchard, paragraphs 75-80. Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard for facilitating steps in registering domain names as well as applying for trademarks before the USPTO as claimed with reasonable expectation of success.

Furthermore, creating a web site on the Internet and receiving information regarding an Entrepreneur that has accessed the Facilitator's web site are non-functional descriptive data.

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When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional

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relationship between the descriptive material and the substrate.

The Examiner asserts that the acts of creating a website and receiving information regarding an Entrepreneur that has accessed the Facilitator's web site can add little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed." Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All prior art revealed in the Information Disclosure Statement filed by applicant is hereby made of record.

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### **Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 7:00 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571)272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/

Examiner, Art Unit 4154

/Vu Le/

Supervisory Patent Examiner, Art Unit 4154